

### **REMARKS**

The present amendment is in response to the Office action dated September 26, 2006, where the Examiner has rejected claims 58 and 62-70 under 35 U.S.C. 102(e) and has rejected claims 59, 60, 61, 71, 72-82 and 83 under 35 U.S.C. 103. In the present amendment, claims 58, 60-61, 68-69, 71-72, 78, and 83 have been amended and claim 59 has been cancelled without prejudice. Accordingly, claims 58 and 60-83 are pending in the present application with claims 58, 69, 72, and 78 being the independent claims. Reconsideration and allowance of pending claims 58 and 60-83 in view of the amendments and the following remarks are respectfully requested.

#### **Claim Rejections Under 35 U.S.C. 102(e)**

Claims 58 and 62-70 are rejected as anticipated under 35 U.S.C. 102(e) based on Wilk (US Patent Number 6,768,789). The Examiner states, in part, that Wilk teaches that "[t]he predefined messages may be provided in a plurality of languages (by inherency, each language offered will be associated with a binary number identifier)." (See, Page 2, Paragraph 2 of the present Office Action.) The current independent claims 58, 69, 72, and 78, as amended, specify limitations which are different from the quotation above from the present Office Action.

By way of example, a portion of independent claim 58 recites "the selected language code being used to retrieve the predefined message in the selected language from the memory of the second wireless communication device."

In Wilk the "selected predefined message" must always be selected by the sender and accessed on the senders device, and then transmitted in its entirety to the receiver. For example, in column 7, lines 24-30, of Wilk it states that:

the present invention can be used where the callee is expecting callers who speak different languages. Accordingly, messages recorded in different languages can be recorded and saved on storage device 40 – the message in the appropriate language being selectable, for example, by

the callee based on the callee's knowledge of the caller's desired language.

In Wilk the "selected predefined message," therefore, is retrieved in its entirety from the sender's (i.e., the calling party) storage device 40 and played back for the caller by sending the whole message over the air. (See also, Wilk at Figure 2, Steps 125-130.) Therefore, if the sender in Wilk sends a message and wants it to be in Spanish, then the sending device retrieves the message in Spanish from the storage device 40 and sends the entire message over the air to the receiver who listens to the message.

In contrast, the present claims specify sending a message code and a language code (not the message itself.) When the receiver gets the message code and the language code, the receiver's device uses its memory to access and play back the message using the message and language codes. (See, Page 12, Lines 7-14 of the present Application.) To that end, the receiver's device has a memory with a message corresponding to the message the sender intended to send - a limitation not taught, described, or suggested in Wilk. (See, Page 12, Lines 7-14 of the present Application.)

Accordingly, the present claims do not necessitate that the entire message itself be sent, as described and required by Wilk. Instead, only codes (e.g., message code and language code) can be sent and then the codes are used by the receiver to play back the message in the selected language from the receiver's memory. For at least these reasons, Wilk does not anticipate current independent claims 58, 69, 72, and 78 or their respective dependent claims. As such, Applicant asserts that current pending claims 58 and 60-83 are in a condition for allowance and respectfully requests that the rejection under 35 USC § 102 be withdrawn.

### **Claim Rejections Under 35 U.S.C. 103**

In the Office Action, claims 61 and 72-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Enns et al., (US Patent Application Publication Number 2002/0116499.) The Examiner states that Enns teaches sending a message from a mobile device to specified recipients, the recipients being in a list stored by the

mobile device. The Examiner states that the combination of the two references makes the claimed invention obvious. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

#### 1. Suggestion or Motivation to Combine

The subject matter of the claimed invention is related to wireless communication devices and improving the transmission efficiency of sent messages. The Wilk reference addresses similar subject matter. The Enns reference, however, is directed toward sending messages to multiple recipients using multiple transports.

There are very significant differences between efficient wireless communications and sending messages to a variety of destinations including email and wired recipients as in Enns. For example, the amount of resources available to wireless devices is nowhere near that which is available to an email or a wired recipient. The physical limitations on memory and power that are faced by engineers developing solutions for wireless devices constrain their ability to create such solutions.

Furthermore, the operating systems for the two different types of computing platforms are universally different. Typically, custom designed operating systems are developed for wireless devices and vary depending on the various types of radios and user interfaces that make up the device. Thus, the solutions developed for desktop computer systems are, just like their operating systems, not applicable to wireless communication devices and there is no suggestion in Enns to modify the teachings of Wilk for more efficient communications.

In the Office Action, the Examiner states that one would be motivated to combine the references because a contact list allows quick and easy communications. (See, Page 4 of the Present Office Action.) This argument, however, does not address the fact that the present invention improves efficiency, not necessarily by using a contact list alone, but by only sending codes over the air and not the message itself, the codes being used at the recipient's device to reconstruct the message. Since Wilk sends the entire message over the air it fails to teach this efficiency consideration and since Enns deals with wired as well as wireless connections it does not address this efficiency concern at all.

## 2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. For example, Wilk sends the entire message over the air. Enns sends messages to disparate recipients using disparate transport mechanisms, which include those that have wired connections.

There is not a reasonable expectation of success when combining Wilk with Enns because sending the entire message over the air will not succeed in improving efficiency in a limited resource environment like an over the air connection, because sending the entire message wastes resources and neither reference implies a solution to the problem. In fact, if Wilk (which sends an entire message over the air) was combined with Enns (which sends the same message to many recipients using disparate transport mechanisms) the proposed combination would exacerbate the problem solved by the present claims, since Wilk combined with Enns would send an entire message over the air many times over.

For example, sending the entire message as taught by Wilk might be sent to 5 recipients over the air, 5 recipients over a land line, and 5 recipients via email. This solution is even less efficient than Wilk alone since the same overhead that exists in Wilk (sending the whole message) would be compounded 5 times over in the present example. The solution presently claimed is to only send the codes and to reconstruct the message on the recipient device using the codes, which saves considerable

resources. There is no reasonable expectation of succeeding at this goal when Wilk is combined with Enns.

### 3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claimed invention. The Wilk reference discloses a wireless device for retrieving a translation of a message and sending the entire translated message to a receiver. The Enns reference discloses sending a message to multiple contacts using different transmission mediums. In contrast, as discussed above, the present claims specify that the system send codes associated with the message (as opposed to the actual message itself), which is later reconstructed at the receiver (or an intermediary) who has a corresponding copy of the sent message locally in its memory.

Thus, the combination of Wilk and Enns fails to suggest the claimed inventions. Since the combination of references does not include all the limitations of the invention in claims 61 and 72-82, the Applicant requests that the rejection be withdrawn.

Additionally, in the Office Action, claim 59 has been rejected as under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Godoroia (US Patent Number 5,663,715.) The Examiner states that Godoria discloses the decoding of a predefined message by a recipient wireless device. (See, Page 5, Paragraph 5 of the present Office Action.) The Examiner further states that the combination of the two references makes the claimed invention obvious. Applicant has canceled claim 59 rendering the rejection moot.

Additionally, in the Office Action, claims 60 and 71 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Mahr (US Patent Number 6,956,831.) The Examiner states that Mahr discloses:

a wireless messaging system comprising a personalized database and a call control center; in response to the reception of a signal) containing a predefined message initiation code and an identifier of the receiving station) from a wireless subscriber, the call control center retrieves the predefined message and transmits said predefined message to the intended receiving station. (See, Page 6 of the present Office Action.)

The Examiner further states that the combination of Mahr with Wilk makes the claimed invention obvious. The Applicant traverses the rejection for the following reason. Mahr does not deal with any of the problems involved in the translation of messages between languages. Instead, Mahr deals with retrieving a predefined message at a server and sending the message to a receiving station. (See, Mahr, Column 5, Lines 48-59.) The Examiner states that a motivation to combine Mahr with Wilk is for the ability to transmit personalized non-mobile originated predefined messages. (See, page 6 of the present Office Action.)

Mahr, however, does not foresee the difficulties involved in language translation, specifically when applied to an over the air medium where resources are limited. As such, Mahr does not foresee the need for having multiple copies of a message in different languages and translation codes related to which language the message needs to be reconstructed to at the receiver. Therefore, merely having an intermediary reconstruct a message as in Mahr would not motivate a person having ordinary skill in the art to solve a problem related to language translation as it applies to the inherent lack of resources in an over the air connection and the inherent additional resources needed to perform language translation.

Similarly, there would not be a reasonable expectation of success when combining Mahr with Wilk, since Wilk sends the entire message over the air, which wastes resources. Mahr, on the other hand, does not deal with language translation at all so it does not deal with any of the associated problems. As such, there is no reasonable expectation of success to combine Wilk (which does not solve the efficiency problem currently claimed) with Mahr, which does not deal at all with language translation.

Finally, the combination of Wilk and Mahr fail to teach the limitations recited by claims 60 and 71. Neither Wilk nor Mahr teach a language code that is transmitted over the air. Thus, the combination of Wilk with Mahr still fails to suggest the invention of claims 60 and 71. Since the combination of references does not include all the limitations of claims 60 and 71, the Applicant requests that the rejection be withdrawn.

Additionally, in the Office Action, claim 83 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Enns, and in further view of Mahr.

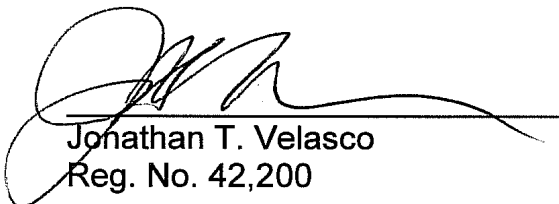
The Examiner states that the rejection with respect to claim 83 is parallel to the rejection with respect to claims 60 and 71. For the same reasons that claims 60 and 71 are in a condition for allowance, claim 83 is in a condition for allowance as well.

### **Conclusion**

For all the foregoing reasons, allowance of claims 58 and 60-83 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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